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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,411	02/13/2002	Mario Meggiolan	Q68509	3978

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EXAMINER	
STAICOVICI, STEFAN	

ART.UNIT	PAPER NUMBER
1732	9

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/073,411	MEGGIOLAN, MARIO	
	Examiner	Art Unit	
	Stefan Staicovici	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 August 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-53* is/are pending in the application.

4a) Of the above claim(s) *34-44 and 51-53* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-33 and 45-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *13 February 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 8 is acknowledged. The traversal is on the ground(s) that "no serious burden exists in examining the application" (see page 2 of the Response filed on August 22, 2003). Under MPEP §803, a prima facie showing of "serious burden" is a showing of "separate classification, or separate status in the art, or a different field of search." As shown in the restriction requirement mailed June 25, 2003 (Paper No. 7), the application as claimed is drawn to a method of molding, classified in class 264, subclass 258; a molding apparatus classified in class 425, subclass 503 and a bicycle wheel rim, classified in class 301, subclass 95.103. Therefore, the inventions as claimed have acquired a separate status in the art requiring multiple searches in different class and subclass combinations.

MPEP §803 further states "[t]hat prima facie showing may be rebutted by appropriate showings or evidence by the applicant." However, Applicant's sole statement that "no serious burden exists in examining the application" does not constitute "appropriate showings or evidence" because it is a mere argument. As such, it is submitted that a serious burden is being placed on the Examiner.

The requirement is still deemed proper and is therefore made **FINAL**.

Claim Objections

2. Claims 1-32 and 46-50 are objected to because of the following informalities: in claims 1 and 46-50, on line 7, after "wherein", "it" should be replaced with "said method". Claims 2-32 are objected to as dependent claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-32 and 46-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claims 1 and 46-50, it is unclear whether the first and second predetermined number of layers are part of the initial predetermined number of layers or added at a later stage in the claimed process. It is suggested that after the limitation of "folding a first predetermined number of the layers on the inflatable bag," to insert the limitation of "while a second predetermined number of layers remain free. "

It should be noted that for the purpose of examination it has been assumed that the first and second predetermined number of layers are part of the initial predetermined number of layers.

Claims 2-32 are rejected as dependent claims.

Specification

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: "Method for Producing a Bicycle Rim."

6. The abstract of the disclosure is objected to because the abstract should be a concise description of a method for making a bicycle rim. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 45 is rejected under 35 U.S.C. 102(b) as being anticipated by Enders (US Patent No. 5,540,485).

Enders ('485) teaches the claimed process for making a fiber reinforced composite bicycle rim including a peripheral outer wall (14) having circumferential wings for mounting a tire, a peripheral inner wall (15) and two lateral walls (see Figure 3), said walls being made form fiber reinforced thermosetting or thermoplastic materials (see col. 8, lines 19-23 and 37-41). Further, Enders ('485) teaches placing fiber reinforced thermosetting or thermoplastic materials

against the inner surfaces of molds (45, 46), positioning a bladder (20) against said fiber reinforced thermosetting or thermoplastic materials, wrapping said fiber reinforced thermosetting or thermoplastic materials around said bladder to form said peripheral inner wall (15) and two lateral walls (inner rim), wrapping said fiber reinforced thermosetting or thermoplastic materials about said peripheral inner wall to form said peripheral outer wall (14c) (outer rim) (see Figures 11 and 16), placing a core (55) (pressure blocking plug) inside said peripheral outer wall (14c), injecting a pressurized gas into said bladder and forcing said fiber reinforced thermosetting or thermoplastic materials into contact with the interior of said molds (45, 46) while curing of said thermosetting or thermoplastic occurs and removing said core after curing of said thermosetting or thermoplastic to form said fiber reinforced composite bicycle rim (see col. 9, line 7 through col. 10, line 9; col. 10, lines 33-35; col. 7, lines 53-55 and Figures 16-18).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Enders (US Patent No. 5,540,485) in view of Lew *et al.* (US Patent No. 6,347,839 B1).

Enders ('485) teaches the basic claimed process for making a fiber reinforced composite bicycle rim including, a peripheral outer wall (14) having circumferential wings for mounting a

tire, a peripheral inner wall (15) and two lateral walls (see Figure 3), said walls being made form fiber reinforced thermosetting or thermoplastic materials (see col. 8, lines 19-23 and 37-41). Further, Enders ('485) teaches placing fiber reinforced thermosetting or thermoplastic materials against the inner surfaces of molds (45, 46), positioning a bladder (20) against said fiber reinforced thermosetting or thermoplastic materials, wrapping said fiber reinforced thermosetting or thermoplastic materials around said bladder to form said peripheral inner wall (15) and two lateral walls (inner rim), wrapping said fiber reinforced thermosetting or thermoplastic materials about said peripheral inner wall to form said peripheral outer wall (14c) (outer rim) (see Figures 11 and 16), placing a core (55) (pressure blocking plug) inside said peripheral outer wall (14c), injecting a pressurized gas into said bladder and forcing said fiber reinforced thermosetting or thermoplastic materials into contact with the interior of said molds (45, 46) while curing of said thermosetting or thermoplastic occurs and removing said core after curing of said thermosetting or thermoplastic to form said fiber reinforced composite bicycle rim (see col. 9, line 7 through col. 10, line 9; col. 10, lines 33-35; col. 7, lines 53-55 and Figures 16-18).

Regarding claim 33, Enders ('485) does not teach machining of said circumferential wings. Lew *et al.* ('839) teach a molding process for a fiber reinforced plastic bicycle rim including, placing fiber reinforced plastic layers onto an inner surface of a lower mold, positioning a core against said layers, overlapping said layer around said core to form circumferential wings for mounting a tire, placing an upper mold, molding said layers to form said fiber reinforced plastic bicycle rim, removing said fiber reinforced plastic bicycle rim from said upper and lower molds and machining said circumferential wings using a router in order to

obtain a desired spacing distance for mounting said tire (see Abstract and col. 6, lines 41-48). Therefore, it would have been obvious for one of ordinary skill in the art to have machined said circumferential wings as taught by Lew *et al.* ('839) in the process of Enders ('485) because, Lew *et al.* ('839) specifically provides that machining provides for an optimization of said spacing distance such that mounting of said tire occurs in an improved manner and also because, both references teach similar materials and end-products that have the same function, hence the same technical requirements must be met by said end-products..

11. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okajima *et al.* (US Patent No. 6,283,557 B1) in view of Lew *et al.* (US Patent No. 6,347,839 B1).

Okajima *et al.* ('557) teach the basic claimed process of making an integral fiber reinforced composite bicycle rim including, a peripheral outer wall (64) having circumferential wings (62) for mounting a tire, a peripheral inner wall (66) and two lateral walls (54) (see Figure 3), said walls being made form fiber reinforced composite (plastic) material (see col. 7, lines 27-30 and Figure 10).

Regarding claim 33, Okajima *et al.* ('557) do not teach machining of said circumferential wings. Lew *et al.* ('839) teach a molding process for a fiber reinforced plastic bicycle rim including, placing fiber reinforced plastic layers onto an inner surface of a lower mold, positioning a core against said layers, overlapping said layer around said core to form circumferential wings for mounting a tire, placing an upper mold, molding said layers to form said fiber reinforced plastic bicycle rim, removing said fiber reinforced plastic bicycle rim from said upper and lower molds and machining said circumferential wings using a router in order to

obtain a desired spacing distance for mounting said tire (see Abstract and col. 6, lines 41-48). Therefore, it would have been obvious for one of ordinary skill in the art to have machined said circumferential wings as taught by Lew *et al.* ('839) in the process of Okajima *et al.* ('557) because, Lew *et al.* ('839) specifically provides that machining provides for an optimization of said spacing distance such that mounting of said tire occurs in an improved manner and also because, both references teach similar materials and end-products that have the same function., hence the same technical requirements must be met by said end-products.

Allowable Subject Matter

12. Claims 1-32 and 46-50 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (703) 305-0396. The examiner can normally be reached on Monday-Friday 8:00 AM to 5:30 PM and alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached at (703) 305-5493. The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

Stefan Staicovici, PhD

Primary Examiner 11/1/03

AU 1732

November 1, 2003